

Remarks/Arguments

I. Rejection Under 35 U.S.C. §112, First Paragraph

Claims 1 and 3-15 were rejected under 35 U.S.C. §112, first paragraph, as being non-enabling for a “non-degradable” container. The non-degradable limitation has been deleted from claim 1 by amendment.

II. Rejections Under 35 U.S.C. §103(a)

Claim 1 has been amended to show that Applicants’ invention is a method of delivering a chemical into a wellbore comprising providing the chemical in a solid slow-release form, introducing the chemical in a meshed-or mesh-like re-usable basket container through which produced fluids can flow without being significantly impeded, and locating the container in the path of the produced fluids, wherein said basket container is comprised of sides comprised of mesh and wherein said solid slow-release chemical is held in the basket container by the mesh. Support for the description of the container is found in the drawings.

Claims 1, 3-5, 7-12 and 16 were rejected under 35 U.S.C. §103(a), as being obvious based upon Bruce (U.S. Patent No. 4,846,279), in view of Johnson (U.S. Patent No. 4,790,386). Bruce describes a system in which a treatment fluid is held in a bladder inside a canister and delivered to a well fluid through a capillary (abstract, and col. 2, lines 18-30). The bottom of the canister may contain at least one aperture, on its bottom wall or on its side, through which the well fluid can enter, thereby subjecting the bladder to the fluid pressure (col. 3., lines 41-63). Johnson describes a system in which the treatment composition is held in a container composed of side walls (col. 2, lines 42-46) a bottom plug (col. 3, line 56) and an open upper end (abstract, and col. 2, lines 38-54). Treatment composition is released by dissolution of the composition at the open upper end of the canister; subsequent corrosion of the walls allows additional treatment composition to be exposed to the well fluid at the upper end of the canister. The methods of the two references work in different ways, and even very selectively combining only a few

elements of either one into the other, as proposed by the Examiner, would destroy its intended function and cause it to fail. For example, not having a hole or holes in the side or bottom would make the method of Bruce inoperable; having a hole or holes in the side or bottom would make the method of Johnson inoperable. If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. M.P.E.P.

§2143.01(V) citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). For this reason, the combination of Bruce and Johnson fails to provide a *prima facie* case of obviousness with respect to Applicants' claims.

Furthermore, neither reference teaches the limitation that the solid slow-release chemical is held in the basket container by the mesh. In order to establish a *prima facie* case of obviousness, the prior art references must teach or suggest all of the claim limitations when combined. See *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974); and MPEP §2143.03.

Claims 1, 13-15 and 17 were rejected as being obvious based upon Moradi-Araghi (U.S. Patent No. 6,387,986) in view of Bruce and Johnson, as applied above. Moradi-Araghi was cited by the Examiner to show that encapsulated chemicals are known in the oilfield and could be delivered by "the container of Bruce and Johnson". However, as explained above, Applicants' invention does not comprise "the container of Bruce and Johnson" so a combination of the three references does not provide the invention of claims 1, 13-15 and 17.

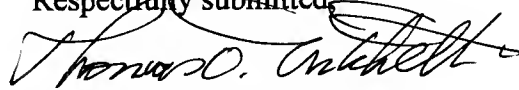
Claims 4, 6, 7 and 9 were rejected as being obvious based upon Bruce in view of Johnson, as applied above, and further in view of Burkhardt *et al.* (U.S. Patent No. 3,104,716). Burkhardt *et al.* describes methods by which a container may be placed and anchored in a well. The Examiner rejects these claims because "the container of Bruce and Johnson" could be placed and anchored by the method of Burkhardt *et al.* However, as explained above, Applicants' invention does not comprise "the container of Bruce and Johnson" so a combination of the three references does not provide the invention of claims 4, 6, 7 and 9.

III. Conclusion

In light of the above remarks, Applicants respectfully request that a timely Notice of Allowance be issued in this case.

A fee for a petition for an extension of time of one month accompanies this Response. The Commissioner is authorized to charge any additional required fee, or credit any excess fee paid, to Deposit Account 04-1579 (56.0719).

Respectfully submitted,



Thomas O. Mitchell
Agent for Applicants
Reg. No. 47,800

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Schlumberger Technology Corporation
555 Schlumberger Drive, MD-21
Sugar Land, Texas 77478
Ph: (281) 285-4490
Fax: (281) 285-8569